

Zettel et al.

S/N: 09/681,573

REMARKS

Claims 1-29 are pending in the present application. In the Office Action mailed June 2, 2005, the Examiner rejected claim 29 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner next rejected claims 1-11, 13-15, 25, 27, and 29 under 35 U.S.C. §103(a) as being unpatentable over Academic Technology Services (hereinafter ATS), and further in view of Bendik (US 2002/0002563). Claims 12 and 16-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over ATS and Bendik, and further in view of Alam et al. (USP 6,336,124). Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS, Bendik, and Alam, and further in view of Ouchi (USP 6,370,567). Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS and Bendik, and further in view of Chen et al. (USP 6,009,442). Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS and Bendik in view of Ouchi.

REJECTION UNDER §112

With respect to the rejection of claim 29 under 35 U.S.C. §112, the Examiner indicated that the claim was open to two different interpretations and was thus rejectably unclear. The Examiner stated that the claim could be read as calling for the processing unit to "route the document to at least one: supervising approver, workflow recipient," or could be read as calling for the processing unit to route the document "to: at least one supervising approver; and workflow recipient." Seemingly, the first interpretation regards the claim as calling for the document to be routed to 1) at least one supervising approver and 2) at least one workflow recipient. The second interpretation appears to infer that the document is to be routed to 1) at least one of a supervising approver and 2) a workflow recipient. Applicant does not necessarily agree that the language of the claim is unclear, or that it must embody one of these two interpretations only. In fact, rather than choose between these two interpretations, Applicant has amended claim 29 to broaden the claim in a manner which encompasses both interpretations. Specifically, Applicant has amended claim 29 to read in the disjunctive so as to encompass processor routing of the document to any of 1) a supervising approver, 2) a workflow recipient, or 3) any combination thereof. Accordingly, Applicant believes that claim 29 conforms to the requirements of §112 and requests that the rejection of claim 29 based upon §112 be withdrawn.

Zettel et al.

S/N: 09/681,573

REJECTIONS UNDER §103

In rejecting claim 1, the Examiner indicated that ATS teaches several elements of claim 1, but recited these elements without reflecting changes made per the Amendment of 3/30/05. While it appears that the Examiner may have substantively considered some portions of the Amendment, such as the document management system, Applicant requests that the Examiner consider the entire Amendment and reflect such consideration should a future rejection be issued.

In addition to not recognizing the amended language, the Examiner also did not address the element of claim 1 calling for the step of "selecting a publication format via the publication enabler," called for in claim 1. The Examiner must show that "the prior art reference (or references when combined) [] teach or suggest all the claim limitations." MPEP §2142. Applicant believes that the Examiner's non-consideration of this element is telling of the fact that the ATS reference does not teach "selecting a publication format via the publication enabler." ATS regards the well-known application "PDFWriter" by Adobe® Systems Incorporated. The program produces only PDF formats of data files. See pg. 3. Thus, a user does not "select" a publication format for a data file, since only one format is possible. For this reason alone, the Examiner has not established a *prima facie* case of obviousness. *Id.*

Also, the Examiner admitted that ATS does not teach or suggest the use of a document management system, and therefore proposed a combination of ATS with the teachings of Bendik. However, Bendik does not teach a document management system as contemplated by claim 1. Bendik teaches a system in which no file format conversion takes place at all. See pg. 2, ¶¶ 0032, 0034; pg. 6, ¶ 0073. In order for a data file to be introduced into the document system, Bendik teaches that a separate file profile 30 must be made, but not that the file itself must be converted or published to any new or different format. *Id.* Specifically, Bendik teaches that "a file system 120 that may contain document content 20 which are stored as individual files as known in the art," and that document profiles are stored in a separate database 40. Pg. 2, ¶ 0034. Thus, the actual data file or document content 20 remains in its original format when stored and accessed by users. Bendik assumes that all users of the system will be able to open the original data files 20 and does not require or contemplate publishing or converting an original data file into another format. See Pg. 6, ¶ 0074. Accordingly, Bendik does not contemplate a situation in which it would be "necessary for publication to the document management system, [to] convert[] the accessed data file directly into another publication format." In other words, since Bendik

Zettel et al.

S/N: 09/681,573

ignores file compatibility in terms of workflow and file transfer, the system therein is not a “document management system” in the context of claim 1.

In addition, since the system of Bendik operates on the assumption that a user’s computer will be able to open any document content file type, there is no need or suggestion in Bendik to incorporate a PDFWriter therewith. *See* Pg. 6, ¶ 0074. Furthermore, Bendik states that a document profile 30 includes alterable “key fields of information or attributes that a user utilizes to define a document content 20” for purposes of categorization and searching within the document management system. Pg. 5, ¶ 0061. Once a document is found, a user may open the document content 20 and edit the information therein. Fig. 8, pg. 5, ¶¶ 0058, 0061. Since the content of PDF files is generally unalterable, and since ATS does not disclose the capability to create searchable profiles linked to an original data file, the aforementioned features of Bendik would be rendered inoperable or useless if the references were to be combined. As such, Applicant respectfully requests that the rejection of claim 1 be withdrawn.

With respect to claim 8, the Examiner stated that “[A]pplicant discloses the computer readable storage device having stored thereon a program for executing the method of claim 1. Claim 8 is similarly rejected under ATS and Bendik.” As Applicant has discussed above, Bendik does not teach a “document management system” in the context of the present invention, and there is no motivation to combine ATS with the teachings of Bendik. The system of ATS is incapable of “publish[ing] the content of the electronic media directly into the at least one publication format in accordance with ... storage rules of the document management system” (emphasis added) of Bendik, since the system of Bendik requires a searchable and alterable two-part file format. *See* pg. 2, ¶¶ 0032, 0034; pg. 6, ¶ 0073. Correspondingly, the system of Bendik would be rendered partially inoperable if the file format of ATS were incorporated therewith, since the content of a PDF file is generally unalterable and unsearchable. Thus, Applicant requests that the rejection of claim 8 and all claims depending therefrom be withdrawn.

In rejecting claim 25, the Examiner stated that ATS teaches “[a] processing unit programmed to call the GUI on demand and enable a user selection of one or more publication formats, wherein the one or more publication formats including publication formats non-native to a creation document (pages 4-5, numbers 3-6),” and that Bendik teaches “conforming data to a document management system with parameters (paragraph 0049).” However, Applicant reiterates that the system of ATS does not afford a user “selection of one or more publication formats.” PDFWriter provides only one output file format and no “selection” of or between

Zettel et al.

S/N: 09/681,573

multiple file formats takes place. *See* pg. 3. In addition, the PDF file format does not fit the parameters for a document of Bendik, and Bendik teaches away from the use of "publication formats non-native to a creation document format." That is, Bendik specifically states that separate applications native to the chosen file types are invoked to create files. Pg. 1, ¶ 0009; pg. 6, ¶ 0073. Therefore, no documents exist in the system of Bendik which have non-native formats. As such, there is no need or motivation to incorporate the teachings of Bendik with that of ATS.

In regard to claim 16, the Examiner cited ATS and Bendik as above and further included Alam. Applicant reiterates that Bendik does not teach the claimed document management system, that there is no motivation to combine the teachings of the ATS reference with Bendik, and that such a combination would be unworkable. In addition, ATS does not teach a system which "transmit[s] the converted data to at least one publication system." Although ATS teaches the creation of converted data files, ATS does not teach that the system therein receives converted data files or that it publishes them to a publication system, as claimed. ATS teaches only the conversion of original data files from an associated application. *See* pg. 3.

In addition, Applicant has also amended claim 16 to call for a "converter configured to convert the electronic data file directly into at least one of a number of publication formats." Alam teaches a process for converting data files which involves several intermediary steps and interim file types before a file is converted to the final format. Col. 5, lns. 54-56.

In addition, one of skill in the art would not be motivated to combine ATS and Alam in the manner which the Examiner has indicated. Alam already expressly describes the manner in which a PDFWriter program interacts with the system therein. Col. 6, lns. 33-49. That is, the Examiner cited ATS as converting documents into publication formats, however Alam teaches the PDFWriter program as being used in an intermediary step of a longer publication process. Accordingly, since there is no motivation to combine ATS with Bendik or Alam, Applicant respectfully requests withdrawal of the rejection of claim 16 and all claims depending therefrom.

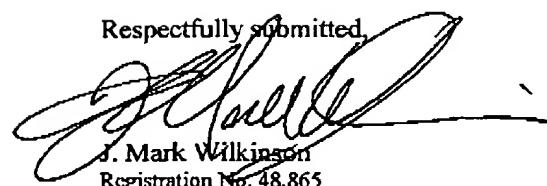
Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-29.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Zettel et al.

S/N: 09/681,573

Respectfully submitted,



J. Mark Wilkinson
Registration No. 48,865
Direct Dial 262-376-5016
jmw@zpspatents.com

Dated: 8/1/05
Attorney Docket No.: GEMS8081.072

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, LLC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170